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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/818,721 | 03/27/2001 | Ronald P. Sansone | F-236 | 1333 |

919 7590 05/10/2005

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EXAMINER

VU, THONG H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2142

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,721

Applicant(s)

SANSONE ET AL.

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/09/05</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-6 are pending.
2. Applicant's arguments, see pages 10-20, filed 3/09/05, with respect to Hilt-Oberlander references have been fully considered and are persuasive. The Final of Office Action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Manduley-Hitt references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable by Manduley [5,648,916] in view of Hitt [6,604,132 B1].
4. As per claim 1, Manduley discloses a method that enables a recipient to inform a carrier of the manner in which the recipient would like the mail delivered, said method comprises the steps of:

depositing with the carrier physical mail containing the recipient's name and physical address and the sender's name and address [Manduley, the fast mail transmitted and received by the computers, col 2 lines 1-20];

translating the name and physical address of the recipient into an e-mail address [Manduley, the fast mail is scanned by scanner, col 2 lines 20-50; converting hard copy paper mail into electronic mail, col 3 lines 58-67].

However Manduley does not detail

capturing the name and physical address of the recipient, and the sender from the physical mail;

notifying the recipient of the availability of the deposited physical mail;

notifying the carrier of the manner in which the recipient would like the physical mail delivered;

notifying the carrier that the sender does not elect the deposited physical mail to be diverted; and

if the sender elects to permit the recipient to divert the physical mail, delivering physical mail to the recipient in the manner specified by the recipient to the carrier.

Hitt discloses a system and method for embedding a physical mailing address in an electronic mail address [Hitt, abstract] wherein capturing the name and physical address of the recipient, and the sender from the physical mail [Hitt, anme and address, col 6 lines 44-67];

notifying the recipient of the availability of the deposited physical mail [Hitt, notified, col 12 lines 49-56];

notifying the carrier of the manner in which the recipient would like the physical mail delivered [Hitt, the physical mail can take many alternative forms, col 11 lines 47-62];

notifying the carrier that the sender does not elect the deposited physical mail to be diverted; and if the sender elects to permit the recipient to divert the physical mail, delivering physical mail to the recipient in the manner specified by the recipient to the carrier [Hitt, the postal service to deliver the physical mail, col 13 lines 28-36].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the technique of embedding a physical mailing address in an electronic mail address as taught by Hitt into the Manduley's apparatus in order to utilize the control of email delivery. Doing so would provide a more effective, efficient and comprehensive way to communicate with people either by email addresses or physical mailing addresses.

5. As per claim 2, Manduley-Hitt disclose the sender places an indication on the mail specifying that the mail should not be diverted by the recipient [Hitt, the physical mail can take many alternative forms, col 11 lines 47-62].

6. As per claim 3, Manduley-Hitt disclose charging the sender for placing an indication on the mail specifying that the mail should not be diverted by the recipient [Hitt, the physical mail can take many alternative forms, col 11 lines 47-62].

7. As per claim 4, Manduley-Hitt disclose the sender places an indication on the mail specifying that the mail should be delivered only as specified by the sender [Hitt, the physical mail can take many alternative forms, col 11 lines 47-62].

8. As per claim 5, Manduley-Hitt disclose charging the sender for placing an indication on the mail specifying that the mail should be delivered only as specified by the sender [Hitt, the physical mail can take many alternative forms, col 11 lines 47-62].

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9. As per claim 6, Manduley-Hitt disclose the recipient notifies a data center who notifies the carrier of the manner in which the recipient would like the mail delivered [Hitt, notified, col 12 lines 49-56].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Rupal Dharja*, can be reached at (571) 272-3880. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

A handwritten signature in black ink, appearing to read 'Thong Vu', with a long horizontal line extending to the right.